



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,941	03/13/2001	Koichi Ikeshima	WATK:210	9068

7590

10/18/2004

PARKHURST & WENDEL, L.L.P.

Suite 210

1421 Prince Street

Alexandria, VA 22314-2805

EXAMINER

DICUS, TAMRA

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/803,941

Applicant(s)

IKESHIMA, KOICHI

Examiner

Tamra L. Dicus

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7 stand rejected under 35 U.S.C. 112, first paragraph, for reasons of record as previously set forth in the action mailed 04/22/04, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-2 and 4-6 stand rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5629067 to Kotani for reasons of record as previously set forth in the action mailed 04/22/04.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,629,067 to Kotani for reasons of record as previously set forth in the action mailed 04/22/04.

Claim 3 stands rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,629,067 to Kotani and further in view of USPN 5,346,722 to Beauseigneur et al. for reasons of record as previously set forth in the action mailed 04/22/04.

Response to Argument

Applicant's arguments filed 07-21-04 have been fully considered but they are not persuasive.

Applicant, during the most recent interview and in the response, argued the 112, alleging that coating artisans know how to apply slurry to a surface. While the Applicant points to this well-known fact, the Applicant does not teach how they do so, specifically as Applicant acknowledges, applying the slurry to the outer wall. Per page 7, lines 10-19 of the disclosure of the instant application, the TEC is higher **when** a cordierite slurry is applied to the outside and fired. There is no mention of how it is applied, so the Examiner takes the position that the

Art Unit: 1774

Applicant has failed to disclose the invention and the body being dipped and fired is the same and the TEC differential remains inherent-hence the motivation for the 112 1st paragraph rejection. While Applicant argues new ways of applying slurry to the outer circumferential wall, e.g. applying tape to the outer wall, and presents an illustration, this figure or these methods are not original filed. If Applicant deems it necessary to include such new matter, the Applicant may do so under a new application. Applicant also argues grinding off the honeycomb structure; however, this discussion is not a limitation in the instant claims. Further because the same materials and places of application are the same, one can only come to one conclusion, the TEC differential is present. Applicant argues that because Kotani teaches applying cordierite and colloidal ingredients, and firing the material, that it should not teach crystalline cordierite.

Applicant has not excluded colloidal alumina or silica from the claims. Further, the specification on page 7 states cordierite when fired produces crystalline cordierite. Further contrary to the present argument, during the recent interview, Applicant stated cordierite when fired produces crystalline cordierite. Thus, the conclusion of the Examiner is that the same cordierite of Kotani when fired produces crystalline cordierite. Applicant argues the declaration. The declaration was considered again. The declarant states that Kotani shows a TEC differential, however, provides no room of giving substantial stress to the inner from the outer portion/wall because of firing. However, as previously provided, that "stress is applied to the inside partition wall from the outer...wall" is a process limitation and is given little weight. The same structure and materials are provided by the prior art, therefore, the same article is taught. Further, the TEC values of the instant application mirror the TEC values of Kotani, and provide the same outer wall versus inner wall TEC differential. Moreover, the Applicant includes the table from the

declaration that shows the TEC higher on the outer walls than the inner walls, thus proving the TEC differential is exactly the same as claimed. Thus, Applicants argument that no stress could occur from the outer to inner structure because the honeycomb has already been fired is not convincing. Additionally, Applicant merely speculates that a stress differential will not occur, which is not evidence.

Applicant argues claims 2, 6, and 7 are allowable based off the contention that claim 1 is not taught. However, these claims are not allowable based off the reasons set forth above and in the previous Office Action.

Beauseigneur is still used to teach the exact same materials involved, a honeycomb structure and an alumina/catalytic coating on the outside and fired.

Conclusively, as explicitly explained, the same material, fired corundum crystalline, is adhered in the same manner, the body being dipped-applied to the outside wall, and hence a higher TEC on the outside than the inside is taught.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

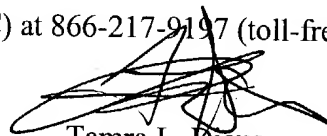
Art Unit: 1774

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

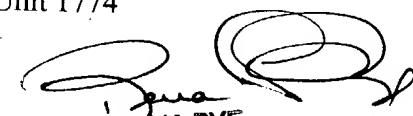
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus
Examiner
Art Unit 1774

October 7, 2004


RENA DYE
SUPERVISORY PATENT EXAMINER

A.U. 1774